APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
SHRADER, LAWRENCE J

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/829,328	MAY ET AL.
	Examiner	Art Unit
	Lawrence Shrader	2124

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 11* is/are pending in the application.

    4a) Of the above claim(s) *6,7 and 11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 5, and 8 - 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Oath/Declaration

1.   The updated declaration filed on 8/17/2004 is acknowledged.

2.   Claims 1 – 5, and 8 – 10 are presented for examination; claims 6, 7, and 11 are cancelled

at the request of the Applicant.

3.   The Applicant's arguments have been fully considered, but are moot in view of the new

grounds of rejection.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-

statutory subject matter. The Federal Circuit has recently applied the practical application test in

determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical

application test requires that a " useful, concrete, and tangible result" be accomplished. An

"abstract idea" when practically applied is eligible for a patent. As a consequence, an invention,

which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine,

manufacture, process or composition of matter, which produces a concrete, tangible, and useful

result. The test for practical application is thus to determine whether the claimed invention

produces a "useful, concrete and tangible result". The claim recites a method of identifying an

entry address, and storing an address. These steps do not necessarily require or strongly suggest

indisputable evidence that some hardware or tangible embodiment is being used because these

steps can be done by virtual analysis or algorithmic computations, e.g. give a series of

elementary/atomic numerical data to a calculating formula written in pseudo-code or tabular

representation done on paper to yield numeric results without the use of an computer-based

execution engine. The claim, as recited, amounts to an abstract idea failing to suggest an

application with a tangible embodiment leading to a concrete and tangible result. Thus, the

claim fails to fulfill the requirements of the practical application test and is rejected for leading to

a non-statutory subject matter.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takaki, U.S.

Patent 4,683,549.

In regard to claim 1:

> *"identifying a permissible entry address by using a correlation of data, wherein the data
> are not provided within a same individual instruction;"*
>
> *"storing, in a memory cell, an address of a correlated data item one of directly before
> and directly after the permissible entry address."*

Takaki discloses identifying a permissible entry address of a program and storing the

address in a table (Abstract and Figures 7 and 8).

In regard to claim 2, incorporating the rejection of claim 1:

> "...which comprises storing, in the memory cell, a reference to a data entry in a
> protected list of legal entry addresses one of directly before and directly after the
> permissible entry address."

Takaki discloses a table of permissible entry addresses (Abstract and Figures 7 and 8).

In regard to claim 3, incorporating the rejection of claim 1:

> "...which comprises directly jumping to the permissible entry address."

See Abstract.

In regard to claim 4, incorporating the rejection of claim 1:

> "...which comprises automatically checking whether the correlation of data is satisfied
> for a respective entry address, when a function call is carried out."

The address automatically correlates through the address table to the appropriate code

(Abstract).

In regard to claim 5:

> "...identifying a permissible entry address by using a correlation of data, wherein the
> data are not provided within a same individual instruction;"
>
> "providing the correlation of data as a correlation with program data in non-reserved
> memory areas."

Takaki discloses identifying a permissible entry address of a program and storing the

address in a table (Abstract and Figures 7 and 8). The table containing the correlation data

would inherently be located in the non-reserved memory area because the reserved area is

typically for operating system components and the history table is part of an application.

> *"providing program instructions not exceeding a given maximum number n of bytes, n being an integer number;"*

> *"providing a specific no-operation code for avoiding random correlations."*

Computer code would inherently contain program instructions not exceeding n bytes

where n in an integer. No-op codes, inherent in all instruction sets, would not exceed the same

fixed length.

In regard to claim 8, incorporating the rejection of claim 6:

> *"...which comprises providing the correlation of data as a correlation between code data items, the code data items being at least n bytes away from one another."*

The table of correlated data (Figures 7 and 8) taught in Takaki would inherently contain

data at least n bytes away from reach other as entries in the table.

In regard to claim 9:

> *"identifying a permissible entry address by using a correlation of data, wherein the data are not provided within a same individual instruction;"*

Takaki discloses identifying a permissible entry address of a program and storing the

address in a table (Abstract and Figures 7 and 8).

> *"providing the correlation of data as a correlation with program data in non-reserved memory areas."*

Takaki discloses identifying a permissible entry address of a program and storing the

address in a table (Abstract and Figures 7 and 8).

"providing a specific byte sequence which cannot occur within a regular code;"

"protecting the permissible entry address by inserting the specific byte sequence."

Takaki provides for an interrupt, which allows a permissible address to be obtained

(Abstarct).

In regard to claim 10, incorporating the rejection of claim 9:

"...which comprises using a specific no-operation code as the specific byte sequence."

Takaki provides for an interrupt, which allows a permissible address to be obtained

(Abstarct).

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lawrence Shrader whose telephone number is (571) 272-3734.

The examiner can normally be reached on M-F 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence Shrader
Examiner
Art Unit 2124

4 November 2004

KAKALI CHAKI
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TECHNOLOGY CENTER 2100